

REMARKS

This is in response to the currently outstanding Official Action in the above-identified application.

Claims 1-14 were present in this application as of the time of the issuance of the currently outstanding Official Action. By the foregoing Amendment, Claims 1, 4, 7-9 and 14 have been amended. Claim 3 has been cancelled, without prejudice, as being redundant in view of the amendment to Claim 1. Applicants do not propose the addition of any New Claims. Accordingly, upon the entry of the foregoing Amendment, Claims 1 and 3-14 as hereinabove amended will constitute the claims under active prosecution in this application.

The claims of this application showing the changes made by this Amendment are shown above as required by the Rules.

More specifically, it is noted that in the currently outstanding FINAL Official Action, the Examiner has:

1. Acknowledged Applicants' claim for foreign priority under

35 USC 119(a)-(d) or (f), and indicated that the required certified copies of the priority document have been received by the United States Patent and Trademark Office (Note: The Examiner indicates that the certified copy was filed in the parent of this application No. 2000-171597 on 06/08/2000, while in fact Japanese Application No. 2000-171597 filed on 06/08/2000 is the priority document for this application).

2. Acknowledged Applicants' Information Disclosure Statement as filed concurrently with this application by providing Applicants with a copy of the Form PTO-1449 that accompanied that Statement duly signed, dated and initialed by the Examiner to confirm his consideration of the art disclosed therein;
3. Indicated that the drawings as filed on 7 June 2001 are accepted;
4. Provided Applicant with a Notice of References Cited (Form PTO-892) and copies of each of the cited references;
5. Objected to the first line of the Abstract on the basis that "a optical" should read -- an optical --;
6. Rejected Claims 1-5 and 7-14 under 35 USC 102(e) as being anticipated by the Saimi et al reference (U.S. Patent No. 6,430,137); and
5. Rejected Claim 6 under 35 USC 103(a) as being unpatentable over the Saimi, et al reference in view of the Sasaki et al reference (U.S. Patent 5,623,465).

Further comment in these Remarks regarding items 1-4 above is not considered to be necessary.

With respect to item 5, Applicant by the foregoing Amendment has changed the wording of the Abstract in the manner suggested by the Examiner. Accordingly, Applicant respectfully submits that the basis for the Examiner's objection to the specification now is moot. A decision so holding in response to this communication is respectfully requested.

Further, Applicant by the foregoing Amendment has proposed a change to paragraph 0060 of the specification including the deletion of "first region", "second region", "third region" and "fourth region" as those terms relate to the photodetector regions 7a-7d. The reason for this change is that in combining the limitations of Claim 3 with those of Claim 1 in the foregoing Amendment it was deemed preferable to refer to first and second photodetector regions rather than third and fourth photodetector regions. In other words, it was deemed to be preferable to refer to first and second photodetector regions in Claim 1 and third and fourth photodetector regions in Claim 4 rather than vice versa. Accordingly, the parenthetical references in the specification to the contrary have been deleted for purposes of clarity. No change in the scope of Claim 3 or Claim 4 arises as a result of this wording change, and no new matter is introduced into the application thereby. Accordingly Applicant respectfully submits that the foregoing amendments to the specification are appropriate. A decision so holding in response to this communication is respectfully requested.

With respect to items 6 and 7, the Examiner asserts that the Saimi et al reference teaches the present invention as claimed with the exception of the storage means and focal shift signal generating means of Claim 6. In the latter regard, the Examiner asserts that the Sasaki, et al reference supplies a teaching of the missing elements. Hence, the Examiner has rejected Claims 1-5 and 7-14 as being anticipated under 35 USC 102(e) and rejected Claim 6 as being unpatentable under 35 USC 103(a).

By the foregoing amendment, Applicants have combined the limitations of Claims 1 and 3, and cancelled Claim 3, without prejudice. Further, Applicants have reworded the claims for clarity by referring to the outer photodetector regions as the first and second photodetector regions in Amended Claim 1, and by referring to the inner photodetector regions as the third and fourth photodetector regions in Claim 4. The remainder of the claims also have been amended so as to follow this convention and the specification has been amended to remove possible confusion between its wording and that of the claims as hereinabove reworded. Applicant respectfully submits that these formal amendments simply improve the clarity of the presentation of the invention and therefore are clearly appropriate.

With respect to the substance of the currently outstanding rejections in view of the foregoing Amendment, Applicant respectfully submits that the present invention as now claimed clearly differs from the Saimi et al reference in that ***the light-receiving means comprises a third region photodetector and a fourth region photodetector arranged in positions apart from the optical axis of the first light beam.***

More specifically, in the present invention as presently claimed, the third region photodetector 7a and the fourth region photodetector 7c are arranged in positions located apart from the optical axis OZ1 of the light beam as shown in Fig. 3 and stated at page 22, paragraph 0062, of the present specification. The Saimi et al reference, on the other hand, fails to teach photodetectors arranged in positions located apart from the optical axes of the light beams. Instead, each of the photodetectors in the Saimi et al reference is disposed so that the optical axis of the light beam is aligned with an edge of the photodetector (see, Saimi, et al at Figs. 3, 4, 6, 7 and 9-15).

In addition, it is to be understood that the Saimi et al reference totally fails to teach, disclose or suggest that all of the photodetectors are to have a common optical axis as presently called for in Amended Claim 7. (Compare the photodetectors depicted in Saimi et al at Figs. 3, 4, 6, 7 and 9-15 with the photodetectors 7c and 7d of the present application as depicted in Figures 3, 4, 5, 8, 9, 11, 13 and 14). The result of the features set forth in Claims 1 and 7 of the present application therefore is that it is possible to simplify the structure of the light receiving means in comparison to the light receiving means taught by the Saimi, et al reference.

Consequently, Applicant respectfully submits that none of the cited references either alone or in combination with one another disclose, teach or suggest the present invention as now claimed. In particular, in order to support an anticipation rejection, Applicant respectfully submits that it must be shown that each and every element of the claim is found either expressly or inherently described in a single prior art reference in as complete detail as that contained in the claim. Applicant respectfully submits that such is clearly not the case here. In the present circumstances, the Saimi et al reference relies upon a single photodetector on either side of the axis of symmetry for the detection of both light quantities near that axis of symmetry and apart therefrom. At the very least, such a structure requires sophisticated circuitry for the separation of "near axis" from "spaced" signals representative of light quantities received. Indeed, the continuum of light impinging upon the photodetectors of the Saimi reference indicates that even if it were to be determined to be possible to separate input from "near" the axis from that "spaced from" the axis, cross-talk between the signal inputs is likely thereby making the need for complex separation circuitry even greater. Hence, while Saimi et al may be indicative of the one of the problems solved by the present invention, it clearly does not disclose, teach or suggest the present invention as required to support an anticipation rejection under 35 USC 102.

Further in order to support a rejection under 35 USC 103(a) the claimed invention must be demonstrated to be present within the “four corners” of the cited art when that art is considered as of the date of the Applicant’s invention by one of ordinary skill in the art. Indeed, the Examiner has the burden of showing a *prima facie* case of the obviousness of the claimed invention in order to justify a rejection under 35 USC 103(a). To the extent that the Examiner’s currently outstanding rejection may be so supported, Applicant respectfully submits that it applies an improper “obvious to try” standard, and should be withdrawn.

The correct standards necessary to support a conclusion (*prima facie* case) of obviousness are as follows:

To establish a *prima facie* case of obviousness under Section 103, Title 35 United States Code (35 US §103), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants’ disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2D 1438 (Fed. Cir. 1991). (See, Manual of Patent Examining Procedure §2142 (8th Edition), at page 2100-2121, *et seq.*)

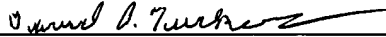
Applicant respectfully submits that not only do the references not disclose the use of photodetectors located both adjacent to and spaced apart from the optical axis of the split light beam under consideration as now claimed, but also that those references totally fail to teach, disclose or suggest that when photodetectors both adjacent to and spaced from the optical axis are used, they all should have the same optical axis. Hence, any suggestion of the present invention as now claimed in the present record is to be found only in the present specification, not in the cited art.

For each and all of the foregoing reasons, it is respectfully submitted that the claims of this application as they will stand upon the grant of entry to the foregoing Amendment are in condition for allowance. Reconsideration of this application, the entry of the foregoing amendment, and the allowance of Claims 1-14 as hereinabove amended in response to this communication, therefore, are respectfully requested.

Finally, Applicants believe that additional fees are not required in connection with the consideration of this response to the currently outstanding Official Action. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge and/or credit Deposit Account No. **04-1105**, as necessary, for the correct payment of all fees which may be due in connection with the filing and consideration of this communication.

Respectfully submitted,

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By: 
David A. Tucker
Reg. No. 27,840
Attorney for Applicant(s)

EDWARDS & ANGELL, LLP
P.O. Box 55874
101 Federal Street
Boston, MA 02109
(617) 517-5508
443109